



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/853,787	05/14/2001	Akihisa Murata	Q64434	7102

7590 07/29/2004

SUGHRUE, MION, ZINN,  
MACPEAK & SEAS, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037

EXAMINER

ZIRKER, DANIEL R

ART UNIT PAPER NUMBER

1771

DATE MAILED: 07/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on 6/3/04
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 2-11 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2-11 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some\* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 2-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Japanese Patent Abstract -164 or applicants' admissions regarding the prior art on page 1 of the specification, each taken in view of the complete English translation of JP -910; the primary references are also further modified by evidence of the state of the art disclosed by either a machine translation of Japanese Publication 07-026223 or Japanese Patent 04-292943, and also further evidenced by PGPub '515 to Shibata et al, substantially for reasons already of record, together with the following additional observations. To partially reiterate, JP -164 discloses a thermally releasable pressure sensitive adhesive sheet comprising a thermally expandable microsphere-containing pressure sensitive adhesive layer coated onto a suitable base and which optionally employs a rubber-like organic elastic layer such as applicants claim in their dependent claims 4 and 10. Additionally, applicants appear to admit on page 1 of the specification that heat peelable pressure sensitive adhesive sheets can comprise a suitable adhesive coated onto a substrate, the adhesive comprising heat-expandable microspheres and which results in an adhesive sheet that can be easily peeled from the adherend. The prior art

"primary references" each lack a teaching of the claimed surface resistivity performance parameter, i.e., a minimal level of antistatic behavior, and also fail to teach surface roughnesses of the type which applicants now claim. JP -910, however discloses (note, e.g., paragraphs 004-0007, particularly 0005, as well as paragraph 0032, and the Examples) pressure sensitive adhesive compositions which exhibit surface resistivity values of the claimed range when either coated onto a suitable backing, i.e. polyester film such as is now set forth in applicants' independent claim 3 or also embodiments in which antistatic compositions can be "applied to the substrate" as set forth in new independent claim 7 of the range which applicants contemplate. As previously set forth, note as evidence of the state of the art JP -223, particularly the Abstract, and paragraph Nos. 0007 and 0009, as well as paragraph No. 006 and the Examples, wherein it is disclosed that antistatic agents of the type applicants claim (paragraph 0009) can be either incorporated into the base film, coated on the base film, or incorporated into the adhesive layer, the particular choice of which is firmly believed to be a mere design parameter. Additionally, note also as evidence of the state of the art the Abstract of JP -943 which coats a suitable self-adhesive layer containing antistatic agent onto a desired thermoplastic resin

base film. Additionally, it is further noted that JP -910 also discloses surface protection of electronic parts in elevated temperature operations such as applicants appear to contemplate.

With respect to the roughness parameter, note again also as evidence of the state of the art U.S. Patent Application Publication -515 to Shibata et al., particularly at page 2, paragraph 12 wherein it is taught that pressure sensitive adhesive layers often exhibit surface roughnesses of 1 micron or finer formed by suitable known surface modification treatments, and by doing so improve the resulting bonding properties of the protective or release sheets to the adhesive layer.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be

Serial No. 09/853,787

-5-

Art Unit 1771

obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

July 26, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1300~~  
1700

*Daniel Zinker*